

REMARKS

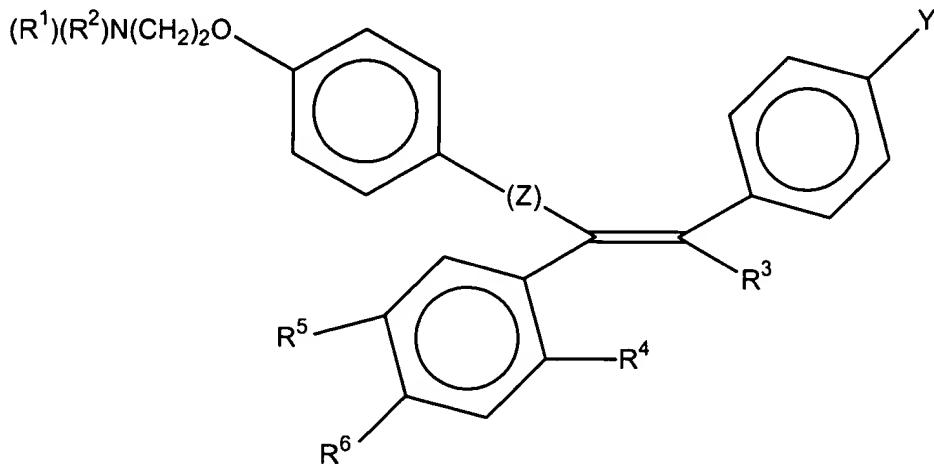
Reconsideration and withdrawal of the rejections of the claims, in view of the amendments and remarks herein, is respectfully requested. In the Office Action, the Examiner indicates that after reconsideration of the Restriction Requirement, claims 158-172, 183-184, 196-199, 204-206, 212-230, and 232 are withdrawn from consideration. However, claims 183-184 are dependent on claim 182, claims 196-199 are dependent on claims 158, 173 and 182, and claims 205-206 are dependent on claims 158, 173, 182 and 200, and claims 173, 182 and 200 were rejected under § 112(2), § 102 and/or § 103 in the Office Action. Thus, it appears that claims 183-184, claims 196-199 as they depend on claims 173 and 182, and claims 205 and 206 as they depend on claims 173, 182 or 200 are included with the elected claims.

Claims 158-172, 195, 204, 212-230, and 232 are canceled, and claims 196-199 and 205-206 are amended. Claims 173-194, 196-203, 205-211, and 231 are pending. Claims 158-172, 212-230 and 232 are canceled solely in response to the Restriction Requirement and without prejudice to their presentation in an appropriately-filed divisional application.

The Examiner rejected claims 173, 182, 207, and 232 under 35 U.S.C. § 112(2) as being indefinite. This rejection is respectfully traversed.

In particular, the Examiner asserts that a “broad” range or limitation, i.e., R^3 is ethyl or chloroethyl, together with a narrow range or limitation, i.e., with the proviso that when R^4 , R^5 and R^6 are H, R^3 is not ethyl, is indefinite and that there is no clear explanation in the specification what compounds fall within this definition. However, the meaning of the claim is clear on its face without reference to the specification. Additionally, the claims (as filed) are part of the original disclosure. Therefore, there is no need for a clear explanation in the specification. The first part of the claim affirmatively defines the compounds and the proviso removes a sub-set of the defined compounds (i.e., compounds wherein R^4 , R^5 , and R^6 are H, and R^3 is ethyl).

Moreover, Examiner is requested to consider page 3, lines 20-23 of the specification, where it is disclosed that a compound of formula (I) includes:



wherein Z is C=O or a covalent bond; Y is H or O(C₁-C₄)alkyl, R¹ and R² are individually (C₁-C₄)alkyl or together with N are a saturated heterocyclic group, R³ is ethyl or chloroethyl, R⁴ is H, R⁵ is I, O(C₁-C₄)alkyl or H and R⁶ is I, O(C₁-C₄)alkyl or H, with the proviso that when R⁴, R⁵, and R⁶ are H, R³ is not ethyl (claim 173), does not include tamoxifen, raloxifene or droloxitene.

Accordingly, withdrawal of the § 112(2) rejection is appropriate and is respectfully requested.

The Examiner rejected claims 173-182, 185-195, 207-211, and 231 under 35 U.S.C. § 102(a) as anticipated by Grainger et al. (U.S. Patent No. 5,595,722). The Examiner also rejected claims 182-195 and 200-203 under 35 U.S.C. § 102(a) as anticipated by the '722 patent. The Examiner further rejected claims 1[sic]-182, 185-195, 200-203, 207-211, and 231 under 35 U.S.C. § 103(a) as unpatentable over the '722 patent. These rejections are respectfully traversed.

The '722 patent is available as a reference under 35 U.S.C. § 102(e) at the latest, as of the filing date of the application from which the '722 patent issued, i.e., June 7, 1995. With respect to the disclosure in the '722 patent which the Examiner asserts anticipates and/or obviates the presently claimed invention, it is Applicant's position that the effective date of that disclosure is the filing date of the application from which the '722 patent issued, i.e., June 7, 1995. Moreover, effective date of the use of a compound of formula (I), or an agent that has reduced estrogenic

activity or reduced DNA adduct formation relative to tamoxifen, as recited in the present claims is June 7, 1995. As the effective filing date of the disclosure in the '722 patent which relates to the presently claimed invention is the same as the effective date of the pending claims, the '722 patent is not available as a reference against the pending claims under 35 U.S.C. § 102(a)/§ 103(a).

Hence, withdrawal of the §§ 102(a) and 103(a) rejections is respectfully requested.

Respectfully submitted,

DAVID J. GRAINGER ET AL.,

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6959

Date April 10, 2003

By Janet E. Embretson

Janet E. Embretson
Reg. No. 39,665

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 10th day of April, 2003.

Name Dawn M. Foley

Signature Dawn M. Foley